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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,062	10/09/2003	Jay S. Walker	02-034	8164
22927 7590 10/26/2010 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
PIERCE, DAMON JOSEPH				
ART UNIT		PAPER NUMBER		
3718				
MAIL DATE		DELIVERY MODE		
10/26/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/682,062

Applicant(s)

WALKER ET AL.

Examiner

DAMON PIERCE

Art Unit

3718

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/10 has been entered.

Response to Amendment

2. The examiner acknowledges the amendments of claims filed on 8/9/2010. Claims 1-48 have been cancelled. Claims 49-69 are pending.

Specification

3. The disclosure is objected to because of the following informalities: pg. 133, line 30 includes the recitation, "no", where it appears it should state, "not".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim include the following recitations which lack proper support in the original specification and are deemed new matter:

- (claim 69) that a wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled; receiving an authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled; and verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled (emphasis added); note, the instant application specification discloses in pg. 77, lines 11-16, "Alternatively, the agency may issue an authorization code that disables a previously-enabled feature. In another example, the state regulatory agency may mandate that a particular feature be enabled, and may issue a corresponding authorization code. A proprietor of a feature (e.g., a game manufacturer, a patent holder) may provide an authorization code. For example, a game manufacturer may sell authorization codes for a particular feature."; where there is supporting disclosure of a

regulatory authority mandating a wagering game (see above), yet not only be played while a specified feature is enabled.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, includes the recitation, "determining, via a processor...", then states, "verifying, by a processor...", (*emphasis added*) where it is unclear whether the "determining" step and the "verifying" step are done with the same or different processors. As best understood, there is one processor accomplishing both steps.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 49-50, 53-54, 57, 59-60, 63-64, and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pub. # 2003/0203756 to Jackson.

Regarding claims 49, 59, Jackson discloses **a method for facilitating play of a wagering game on a gaming device** (abstract and pargs. 13-14, discloses game code within a wagering game system), comprising:

(as required by claim 49) **prior to allowing play of a wagering game including a particular feature and via a processor of a device operable to facilitate the wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority** (lacking clear distinguishing features, Figs. 1-2 discloses wagering game apparatus including a processor, parg. 101 discloses a particular feature set, parg. 106 discloses regulatory authorities providing digital signatures interpreted as an authorization code in wager game systems, and parg. 145 discloses verification at the start of each game played);

(as required by claim 59) **prior to allowing play of a wagering game on a particular gaming device, determining via a processor of a device operable to facilitate the wagering game whether an authorization code for enabling play of the wagering game on the particular gaming device has been received from a regulatory authority** (lacking clear distinguishing features, Figs. 1-2 discloses wagering game apparatus including a processor, and parg. 106 discloses regulatory authorities providing digital signatures interpreted as an authorization code in wager game systems, where verification of the digital signature(s) enables game play);

(as required by claims 49, 59) **verifying, via the processor, an expiration condition for the authorization code** (parg. 111, discloses expiration of digital signatures); and

only if the expiration condition has not yet been met, allowing play of the wagering game (as required by claim 49) **with the particular feature**, and (as required by claim 59) **on the particular gaming device** (parg. 111, discloses expiration of digital signatures, thus, when a digital signature has not expired, game play is still allowed at that the gaming device including the particular feature set).

50, 60, Jackson discloses the method, wherein the expiration condition is a date on which the authorization code is no longer valid (see parg. 111).

53, 63, Jackson discloses the method, further comprising: prior to allowing play of the wagering game, confirming via the processor that an authorization code disallowing play of the wagering game has not been received from the regulatory authority (lacking clear distinguishing features, see parg. 80, where upon verification that a game code is certified and/or approved by a regulatory authority is an indication that a code disallowing play has not been received from the regulatory authority).

54, 64 Jackson discloses the method further comprising: updating, via the processor, data corresponding to the expiration condition after allowing play of the wagering game (see pargs. 111-112).

57, 67, Jackson discloses the method, further comprising: requesting, via the processor, a new authorization code from the regulatory authority if the expiration condition has been met (lacking distinguishing features, see parg. 111 discloses expiry and replacement data related to digital signature).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 51-52, 55-56, 58, 61-62, 65-66, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. # 2003/0203756 to Jackson in view of Nguyen (US 2002/0071557 A1).

Regarding Claims 51, 52, 55, 56, 61, 62, 65, 66, Jackson fails to explicitly disclose the following elements:

(as required by claims 51, 61) wherein the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid;

(as required by claims 52, 62) wherein the expiration condition is a maximum sum of wagers for which the authorization code is valid;

(as required by claims 55, 65) wherein updating data comprises updating the sum of wagers placed on the wagering game based on a wager currently placed on the wagering game;

(as required by claims 56, 66) updating data comprises updating a number of plays of the wagering game played based on a current play of the wagering game; and

(as required by claims 58, 68) purchasing the authorization code from the regulatory authority.

However, Nguyen discloses (as required by claims 51, 61) wherein the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid (lacking clear distinguishing features, pargs. 18, 43,48, 69, discloses a per-use license, and parg. 76, discloses game usage data); (as required by claims 56, 66) updating data comprises updating a number of plays of the wagering game played based on a current play of the wagering game (pargs. 69 and 73, discloses game usage data associated with license expiration data); (as required by claims 52, 62) wherein the expiration condition is a maximum sum of wagers for which the authorization code is valid (parg. 76 discloses license expiration associated with game usage data, where in this case, the game usage data corresponds to a sum of wagers since each game has an required wager amount required to play, thus, the game usage data may include total wager amounts as disclosed in US Pat. 5,470,079 to LeStrange et al); (as required by claims 55, 65) wherein updating data comprises updating the sum of wagers placed on the wagering game based on a wager currently placed on the wagering game (lacking clear distinguishing features, parg. 76, discloses game usage data including the number of times a gaming license has been used, including records of wagering and game play totals); and (as required by claims 58, 68)

purchasing the authorization code from the regulatory authority (see pargs. 20, 48, 69, and 77, discloses gaming license associated with billing data).

The gaming system of Jackson would have motivation to use the teachings of Nguyen in order to ensure game owners continually receive monetary compensation based on use of their respective games.

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the in to modify the gaming system of Jackson with the teachings of Nguyen in order to generate a continuous stream of revenue for game owners as long as their game is relatively popular.

13. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (US 2002/0071557 A1) in view of US Pub. # 2003/0203756 to Jackson.

Regarding claim 69, Nguyen discloses **a method for verifying play of a wagering game in accordance with a feature** (lacking clear distinguishing features, see pargs. 48, where wagering game(s) are played in accordance with game licenses), comprising:

determining, via a processor of a computing device, that a wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled (lacking clear distinguishing features, see pargs. 16-18, where a wagering game can only be played when a license which is interpreted as the feature is approved);

receiving an authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has

only been allowed to be played while the feature was enabled (lacking clear distinguishing features, *parg.* 16, discloses a gaming machine receiving gaming transaction data from a remote server, where the gaming transaction data includes information pertaining to game usage, software, status, and licensing); and

Nguyen is silent on verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled.

Jackson discloses **receiving an authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled** (lacking clear distinguishing features, *parg.* 106, discloses digital signature interpreted as an authorization code from a manufacturer/designer, and the digital signature ensures the game code has not been altered); and

verifying, by a processor and by decrypting the authorization code (*parg.* 105, discloses decrypting the digital signature), **that the wagering game has only been allowed to be played while the feature was enabled** (see *pargs.* 101-106 and 111, where according to the digital signature the game can only be played when the digital signature has been verified). The gaming system of Nguyen would have motivation to use the teachings of Jackson in order to ensure games are played according gaming regulations.

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the in to modify the gaming system Nguyen of with the teachings of Jackson in order to ensure games are played according gaming regulations.

Response to Arguments

14. Applicant's arguments with respect to claims 49-69 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAMON PIERCE whose telephone number is (571)270-1997. The examiner can normally be reached on 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/
Primary Examiner, Art Unit 3718

DJP